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IN THE

Supreme Court of the United States

OCTOBER TERM, 1954.

No. 500

JAMES J. GEARON, MARY E. GEARON, AND MARY E. GEARON, AS EXECUTRIX OF THE ESTATE OF EDWARD GEARON, DECEASED,

Petitioners,

vs.

THE UNITED STATES,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS.

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TABLE OF CONTENTS.

	PAGE
Opinion Below	2
Jurisdiction	2
Questions Presented	2
Constitutional Provisions and Statutes Involved	3
Statement of the Case	4
Reasons for Granting the Writ	7
Conclusion	18
Appendix A, Decisions of Lower Court	19
Appendix B, Federal Statutes and Constitutional Provisions	32
Appendix C, Applicable Court Rules	36

TABLE OF CASES CITED.

Ackermans v. General Motors Corp., 202 F. (2d) 642 (certiorari denied 345 U. S. 996)	11
Agawam Woolen Co. v. Jordan, 7 Wall. 583 at 607	8
Allbright-Nell Co. v. Autosteam Process Co., 70 F. (2d) 959	17
Allen-Qualley Co. v. Shellmar Products Co., 31 F. (2d) 293, 297	12
American Gramaphone Co. v. Leeds & Catlin Co., 170 F. 327, 331	9
Chemical Foundation v. General Analine, 99 F. (2d) 276 (certiorari denied 305 U. S. 654)	16
DeFilippis v. Chrysler Corp., 53 F. Supp. 977 (affirmed 159 F. (2d) 478)	11

Eibel Process Co. v. Minn. & Ontario Paper Co., 261 U. S. 45 12
Hartford Empire v. U. S., 323 U. S. 386 11
Hoeltke v. C. M. Kemp Mfg. Co., 80 F. (2d) 912, 923 (certiorari denied 298 U. S. 673) 11
Holcombe v. McKusick, 20 Howard 552, 554 14
Insul Wood Insulation Corp. v. Home Insulation, 176 F. (2d) 502 12
Kendall v. Winsor, 21 Howard 322 11
Klebe v. U. S., 263 U. S. 188, 191 16
Lorenz v. Colgate-Palmolive Peet Co., 167 F. (2d) 423, 429-430 12
Midland Flour Milling Co. v. Bobbitt, 70 F. (2d) 416, 418 10
Picard v. United Aircraft Corp., 128 F. (2d) 632, 637 (certiorari denied 317 U. S. 651) 12
Pieper v. White Dental Mfg. Co., 228 F. 30 (certiorari denied 241 U. S. 690) 10
Shellmar Products v. Allen-Qualley Co., 87 F. (2d) 104, 107 (certiorari denied 301 U. S. 695) 12
Solomons v. U. S., 137 U. S. 342 11
Union Sulphur Co. v. Freeport Texas Co., 251 F. 634, 255 F. 961 (certiorari denied 249 U. C. 618) 14
U. S. v. Alexander, 148 U. S. 186 16
U. S. v. Girault, 11 Howard 22, 31-32 14
U. S. v. Great Falls Mfg. Co., 112 U. S. 645 16
U. S. v. Société, etc., 224 U. S. 309 16
Virginia Shipbuilding Corp. v. U. S. Shipping Board, 292 F. 440, 22 F. (2d) 38 (certiorari denied 276 U. S. 625) 17
Zachos v. Sherwin-Williams, 177 F. (2d) 762 12

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THE UNITED STATES,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Come now the petitioners, James J. Gearon, Mary E. Gearon, and Mary E. Gearon as Executrix of the Estate of Edward Gearon, deceased, by their counsel, and pray that a writ of certiorari issue to review the judgment of the Court of Claims granting the motion of the United States dismissing Counts II and IV of the petition and granting the motion of the United States for summary judgment as to Count I of the petition and dismissing the petition, and denying petitioner's motion for summary judgment.

OPINION BELOW.

The opinion of the Court of Claims of November 3, 1953, dismissing Counts II, III and IV is reported in 115 F. Supp. 910, and is set out at page 19 of the Appendix filed herewith.

The opinion of the Court of Claims of June 8, 1954, granting respondent's motion for summary judgment and dismissing the petition and denying petitioners' motion for summary judgment, is reported in 121 F. Supp. 652, and is set out at page 24 of the Appendix.

A copy of the Order of the Court of Claims denying the petitioners' motion for rehearing is found at page 31 of the Appendix.

JURISDICTION.

The above opinions of the Court of Claims were handed down November 3, 1953, and June 8, 1954, respectively. The petition for rehearing was denied October 5, 1954.

The jurisdiction of this Court is invoked under 62 Stat. 928, Title 28, U. S. Code, § 1255, (1952 Ed.). (Appendix, p. 32.) The relevant portion of the statute being:

> "Cases in the Court of Claims may be reviewed by the Supreme Court by the following methods;
> (1) By writ of *certiorari* granted on petition of the United States or the claimant."

QUESTIONS PRESENTED.

1. Whether a publication on December 20, 1941, is more than one year prior to an application for patent, when December 20, 1942, falls on Sunday and the patent application is received and filed in the Patent Office on Monday, December 21, 1942.

2. Whether a newspaper article which merely announces the existence of an invention without details of its construction constitutes a prior description in a publication that will invalidate a patent on the invention under Title 35 U. S. Code, §31.

3. May the United States, after requesting that inventions of a military character be submitted to the War Department rather than to the Patent Office, so receive and construct the invention, then claim its test use to be a prior "public use" so as to invalidate a patent on the invention.

4. Whether an inventor's filing of his drawings and specifications, including claims, of an invention and the payment of the statutory fee within a year of an alleged use or publication constitutes a sufficient compliance with the one year limitation in Title 35, U. S. Code, §31.

5. Whether an inventor-patentee is entitled to compensation for the use of his invention by respondent prior to issuance of a patent thereon where it was submitted to the respondent in confidence, and in view of the provisions of Title 35, U. S. Code § 42. (Appendix, p. 34.)

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED.

1. The pertinent provision of the Fifth Amendment to the Constitution of the United States is as follows:

> "• • • Nor shall private property be taken for public use without just compensation."

2. The Act of Congress of July 17, 1952, Ch. 930 §1, 66 Stat. 757 (Title 28, U. S. Code, §1498, 1952 Ed. p. 4205) Patent Cases. See Appendix, p. 33.

3. The Act of Congress of March 2, 1927, Ch. 273 §14, 44 Stat. 1337; (Title 35 U. S. Code, 1940 Ed. §21, p. 3160) Day for Taking any Action or Paying any Fee Falling on Sunday. (Appendix, p. 32.)

4. The Act of Congress of August 5, 1939, Ch. 450 §1, 53 Stat. 1212 (Title 35, U. S. Code, §31, 1940 Ed. p. 3161) Inventions Patentable. See Appendix, p. 33.

5. The Act of Congress, July 1, 1940, Ch. 501 §1, 54 Stat. 710, (Title 35, U. S. Code, §42, 1940 Ed. p. 3164) and as extended by the Act of Congress of June 16, 1942, Ch. 415 Public Laws, 56 Stat. 370. Patents: Publication Detrimental to Public Safety, etc. See Appendix, p. 34 and p. 35.

STATEMENT OF THE CASE.

The petitioners in 1953 filed their petition in the Court of Claims for compensation for the use by the United States of their invention and patent on an Inflatable, Collapsible Military Pontoon Bridge, consisting of four Counts, under the provisions of Amendment V of the Constitution of the United States, and 62 Stat. 940, Ch. 646 §1 (Title 28, U. S. Code §1491, 1952 Ed. p. 4204) *Claims against United States Generally.* Appendix, p. 32; and 66 Stat. 757, Ch. 930 § 1 (Title 28, U. S. Code, § 1498, 1952 Ed. p. 4205) *Patent Cases,* Appendix, p. 33; and 54 Stat., 710, Ch. 501 § 1 (Title 35 U. S. Code, § 42, 1940 Ed. p. 3164, as extended by amendment as approved June 16, 1942, Ch. 415 Public Laws, 56 Stat. 370.) *Patents: Publication Detrimental to Public Safety, etc.* Appendix, p. 34 and p. 35.

Count I prayed compensation for the use of the invention and patent; Count II for compensation for use of the invention before the issuance of the patent; and Count IV for the unauthorized use of the invention before and after the patent grant. The action on Count III is not complained of here. (R. 1.)

The action of the Court of Claims set out in "Opinion Below" is the subject of this petition.

The facts alleged and admitted by this motion are:

Early in 1940 the Government appealed to inventors to submit their inventions of a military character to the War Department rather than to file applications in the Patent Office. (Petition, R. 6 and 7.)

Heeding this patriotic appeal, the petitioners, in August, 1940, submitted drawings and specifications of their pontoon bridge to the United States Army Engineers who in turn requested that the plans be sent to "The Chief of Engineers, United States Army"; this, petitioners did. (Petitioners' Exhibit No. 1 and 2, R. 7 and 14.)

The Adjutant General's office informed petitioners that their device did not possess sufficient value for military purposes to warrant consideration. (Petitioners' Exhibit No. 3, R. 15.) However, on December 20, 1941, a news item appeared in The Chicago Tribune stating a new pontoon bridge of radical new design had been constructed and tested by United States Army Engineers to cross the Chattahoochin River, in Georgia. (R. 9.)

In response to petitioners' letter to the War Department, in January, 1942, General E. S. Adams referred them to the National Inventors Council. (Petitioners' Exhibit No. 4, R. 16.)

In the letter of transmittal to the Council in February, 1942, petitioners said "a military pontoon bridge *was given a test* by United States Engineers at Fort Benning, Georgia, in December 1941, constructed and assembled in almost exact accordance with the drawings and descriptions of my invention which I had submitted". Petitioners therein requested the Council to "investigate my claim for compensation for its use by the United States Government." (Petitioners' Exhibit No. 5, R. 17.)

The Council in May, 1942, wrote petitioners their sug-

gestion "is not of such character as may be employed in the war effort at the present time". (Petitioners' Exhibit No. 7, R. 19.)

In August, 1942, petitioners wrote the Commissioner of Patents asking for an opinion as to whether they were now free to apply for a patent on their invention. (Petitioners' Exhibit No. 8, R. 20.) They received no reply.

In October, 1942, the petitioners filed in the Patent Office drawings and specifications of their invention and paid the initial filing fee but at that time did not file a formal petition and oath. (Defendant's Exhibit A, R. 39.)

On December 19, 1942, petitioners forwarded to the Patent Office the executed Petition and Oath. (Respondent's Exhibit A, R. 42.) As December 20, 1942, fell on Sunday, these were marked filed by the Patent Office, Monday, December 21, 1942. (R. 43.)

Petitioners were granted a Patent on the military pontoon bridge July 15, 1947. (R. 2.)

In 1950, petitioners in a letter advised the War Department their bridge was given a test at Fort Benning in 1941, that the Government was using their bridge, that they demanded compensation for its use and requested a conference with the appropriate officials in respect to these matters. (R. 51, Respondent's Exhibit B, letter attached.)

The petitioners, in 1951, in conference with the War Department claimed compensation for the use of their invention and patent, which was denied. (R. 48.)

The Court of Claims on November 3, 1953, dismissed Counts II, III and IV (R. 29) and on June 8, 1954, granted the respondent's motion for summary judgment. (R. 65.) The petitioners' motion for rehearing was denied October 5, 1954. (R. 71.)

REASONS FOR GRANTING THE WRIT.

The Court of Claims, in its decision, miscalculated the time for filing an application for patent under 44 Stat. 1337, Title 35 U. S. Code § 21. (Appendix, p. 24.)

The decision of the Court of Claims if allowed to stand overthrows all the established judicial decisions respecting the requirements of a description of an invention in a prior publication necessary to invalidate a patent.

The decision of the Court of Claims further reverses the judicial decisions holding that the user of an invention or patent receiving knowledge of the same in confidence from the inventor is estopped from asserting his prior use to invalidate the patent of the inventor.

This decision in effect rewrites 53 Stat. 1212 (Title 35 U. S. Code, § 31, 1940 Ed.) in that it holds it is no longer necessary to establish a "public" use more than one year prior to the patent application to invalidate the patent.

Lastly, the decision, adhering to strict formalism in following the rules as to patent applications, denies just compensation to an inventor who in a time of emergency submitted his invention in confidence to the War Department rather than to the Patent Office.

I.

The decision of the Court of Claims appears to be based solely on the following:

> "The publication in The Chicago Tribune on December 20, 1941, sworn to by the plaintiffs as showing the use of the Gearon invention, was more than one year prior to the completion of the Gearon application in the Patent Office, and the patent is therefore unenforceable because of this statutory bar." (Opinion, R. 69.)

December 20, 1942, fell on Sunday.

It is provided in 44 Stat. 1337 (Appendix, p. 32) as follows:

> "When the day, or the last day fixed by statute for taking any action * * * in the United States Patent Office falls on Sunday * * * the action may be taken * * * on the next succeeding secular or business day." (Appendix, p. 32.)

It is admitted petitioner Gearon forwarded his application to the Patent Office December 19, 1942 (R. 42) and that the application was received and filed by the Patent Office Monday, December 21, 1942. (R. 38.)

For the purpose of computing one year from the date of the publication the effect of the Sunday statute extended the date for filing the application to Monday, December 21, 1942. Applying the statute thus, the publication was exactly one year before the application was filed.

However, under the provisions of 53 Stat. 1212; Title 35 U. S. Code § 31 (Appendix, p. 33) the description of the invention must appear in a publication *more* than one year prior to the application. Moreover the statute does not say more than one year prior to the *filing* of the application. (Appendix, p. 33.) *Agawam Woolen Co.* v. *Jordan,* 7 Wall 583, at 607.

Consequently, the Court of Claims, in overlooking the application of the Sunday statute to compute the time as between the dates of the publication and the filing of the patent, arrived at a conclusion which is erroneous and without support.

We feel these observations are particularly significant because the Court of Claims did not anywhere in its opinion hold that there was a prior "public" use of the invention that invalidated the patent but based its decision solely upon this Tribune publication.

We do not belabor this point as we feel it self-evident under the statutory provisions.

II.

The whole of the publication referred to above and in the opinion (R. 66) is as follows:

> "United States Army engineers yesterday threw a 315 foot pontoon bridge across the Chattahoochin river in 2 hours and 6 minutes. This was one hour less than the previous record for a similar span. Col. L. E. Oliver, armored force engineering officer, said the bridge was a radically new design, utilizing rubber balloon pontoons that support two steel treadways. Because of the new bridge strength, 20 ton tanks can cross it at a fair speed, and 12 ton tanks can step it up even faster. There is no speed limit for trucks. Its construction requires only half the number of men needed for old type bridges." (Appendix, p. 25, Opinion of Court of Claims, June 8, 1954.)

We submit this news story was only a naked assertion that a certain result had been accomplished. This is not a sufficient description in a printed publication to invalidate the subsequent patent within the purview of 53 Stat. 1212 (Title 35, U. S. Code § 31, 1940 Ed.) *American Gramaphone Co.* v. *Leeds & Catlin Co.*, 170 F. 327, at 331.

How was it constructed? How did it collapse? How was it inflated? Was it in sections? If so, how were the sections joined together? Was it bullet proof? Was it rigid or flexible? We find no answers in the news story.

Even to the mind of a skilled engineer would this report in The Chicago Tribune conjure up such a structure as to satisfy the rule that:

> "To be effective as an anticipation, the printed or public disclosure of the subject of patent must be in such terms as to enable a person skilled in the art of

the science to which it pertains to make, construct, and practice the invention without assistance from the patent which it is said to have anticipated." *Midland Flour Milling Co.* v. *Bobbitt*, 70 F. (2d) 416, at 418; Also, *Pieper* v. *White Dental Mfg. Co.*, 228 F. 30. (Certiorari denied, 241 U. S. 690.)

This test has been so consistently applied, but for the decision of the Court of Claims, we should have thought it would not be subject to challenge. Could even a skilled engineer, from this article, make or construct the Gearon or any pontoon bridge?

It is inconceivable that the War Department would now contend it permitted the publication of the description of a new military pontoon bridge within the purview of Title 35, U. S. Code § 31, just fourteen days after Pearl Harbor.

III.

Fevered war conditions in 1940 impelled the War Department to publicly request that inventions of military character be submitted to it rather than to the Patent Office to avoid giving aid and comfort to the enemy. (Respondent's Exhibit A, in letter October 1, 1942, R. 39; Petition Count IV.) (As to all exhibits see Rule 10(c), Appendix, p. 36.) This request presupposed any such submission would be secretly handled, else its value would be lost.

Petitioners in so submitting their invention of a military pontoon bridge had every reason to believe that it would be treated in confidence by the Government. Upon the first submission of the invention, the receipt of the War Department acknowledged that "Application for patent on this bridge has not been applied for." (Petitioners' Exhibit No. 1, R. 14.)

Then later, General E. S. Adams wrote the petitioners, "It is desired to thank you for your interest in submitting

the proposal *for examination.*" (Petitioners' Exhibit No. 3, R. 15.) This is a sufficient admonition to even a layman that the inventor has reposed confidence in the recipient. In the light of its statements and conduct the War Department clearly did not consider that the petitioners intended to transfer their rights to the invention by submitting it to them. Ordinary concepts of fair play require that in all dealings with the petitioners, the War Department was obligated to respect that confidence.

An express agreement to treat the disclosure in confidence is not necessary. An agreement will be implied. *Ackermans* v. *General Motor Corp.*, 202 F. (2d) 642 (Certiorari denied 345 U. S. 996); *DeFilippis* v. *Chrysler Corp.*, 53 F. Supp. 977 (affirmed 159 F. (2d) 478). And this rule is equally binding upon the Government. *Solomons* v. *U. S.*, 137 U. S. 342; *Hartford Empire* v. *U. S.*, 323 U. S. 386.

The respondent admits under this motion that the invention was received by it in confidence and the decision of the Court of Claims ignored this fact. A much cited and leading case concisely stated:

> "It would be a reproach of any system of jurisprudence to permit one who has received a disclosure in confidence to thus appropriate the ideas of another without liability for the wrong." *Hoeltke* v. *C. M. Kemp Mfg. Co.* (1935) (4th Md.), 80 F. (2d) 912, at 923 (Certiorari denied in (1936) 298 U. S. 673); also *Kendall* v. *Winsor*, 21 Howard 322.

Furthermore, it is only a *public* use of an invention more than one year prior to an inventor's application that will invalidate the patent. (Title 35, U. S. Code § 31, Appendix p. 33.) The pontoon bridge constructed and assembled in accordance with the directions and specifications submitted by the petitioners "was given a test" at Fort Benning. This is admitted by the respondent. (Respondent's Exhibit B, in letter attached, R. 51; and Petitioners' Exhibit No. 5, R. 17.)

The grant of a patent presumes that it was not anticipated by prior knowledge or use, *Eibel Process Co.* v. *Minnesota and Ontario Paper Co.*, 261 U. S. 45; *Insul Wood Insulation Corp.* v. *Home Insulation*, 176 F. (2d) 502; and such a prior use to defeat this presumption must be proved beyond a reasonable doubt. *Zachos* v. *Sherwin-Williams*, 177 F. (2d) 762.

By accepting this invention in confidence "for examination" and by putting it to a "test", the Government surrendered its privilege as a member of the public and is estopped from asserting such use invalidates the patent. *Picard* v. *United Aircraft Corp.*, 128 F. (2d) 632, at 637 (Certiorari denied 317 U. S. 651); *Allen-Qualley Co.* v. *Shellmar Products Co.*, 31 F. (2d) 293, 297; *Shellmar Products Co.* v. *Allen-Qualley Co.*, 87 F. (2d) 104, 107 (Certiorari denied 301 U. S. 695).

Why did not the Government deny it was the petitioners' invention and patent that it used?

The Court of Claims nowhere in its opinion said the use by the War Department, that provided the statutory barrier to the enforcement of a patent, was a "public use." (Appendix, p. 24.) The only case cited and the one relied upon by the Court of Claims to buttress its decision (*Lorenz, et al.* v. *Colgate-Palmolive-Peet Co.*, 167 F. (2d) 423, 429-430) held the Lorenz patent void by reason of prior *public* use. (Appendix, p. 28.) If a use, admitted to be a test, more than one year prior to an inventor's patent application, will render it unenforceable, the word "public" should be stricken from the statute. If the decision of the Court of Claims stands, it has in effect, to that extent rewritten the statute.

IV.

The strict construction of the requirements of a patent application, as applied in this case on the motion for summary judgment by the Court of Claims, purloins the petitioners' invention and patent, precludes compensation for its use and denies petitioners their day in court. As this is not a case of adversary claimants or patentees litigating for the same invention and patent, nor a case where the priority of a senior and junior application is involved, it seems to us justice would be served and no injustice would be visited on the Government by avoiding severe formalism and holding the application was effectively filed in October, 1942.

The petitioner, James J. Gearon, a layman, after several rebuffs from the War Department, on October 3, 1942, himself forwarded the drawings and claims of his invention with the $30.00 fee to the Patent Office. True, the letter of transmittal is not such an application as a skilled patent attorney would have prepared, but certainly it contained all, and even more information than is found in the formal Petition filed subsequently. (R. 17, petitioner's letter.) Compare formal petition. (R. 43.)

The petitioners' atempted compliance certainly warned the public, and the Government, that the petitioners were seeking a patent on the bridge and had not dedicated their invention to the public. In fact, the Commissioner of Patents advised the petitioners "You have 6 months from this date, to deposit the missing part." (Defendant's Exhibit A, footnote, R. 41.) The petitioners furnished it in a little over two months. Our claim of strict formalism is exemplified by the fact the publication claimed to be fatal appeared only nine months and thirteen days before petitioners' drawings, claims and fee were received in the Patent Office.

Amendments of applications to add claims within the scope of the invention disclosed in the original application are allowed and relate back to the time of the filing of the original application. *Union Sulphur Co.* v. *Freeport Texas Co.*, 251 F. 634, 255 F. 961 (Certiorari denied 249 U. S. 618).

Adherence to this severe construction puts the petitioners in the ironical and unjust position "as having nothing, but possessing everything."

V.

Petitioners ask review of the order of the Court of Claims of November 3, 1953, dismissing Counts II and IV, holding these counts did not set forth causes of action over which it had jurisdiction. (Appendix, p. 19.)

This request is proper because that order was not a reviewable decision until final judgment on the entire petition was entered on October 5, 1954. There is no specific rule of the Court of Claims covering the situation of multiple counts with differing dates of decision thereon, but Rule 54(b) of the Federal Rules states that any order adjudicating less than all claims is not final. (Appendix, p. 37.)

The same result would have obtained under the single judicial unit theory followed prior to adoption of Federal Rules. *U. S.* v. *Girault*, 11 Howard 22, 31-32; *Holcombe* v. *McKusick*, 20 Howard 552, 554. Applying this theory, Counts I, II, III, and IV constituted a single judicial unit and the order of dismissal lacked finality until the entire unit was adjudicated.

Counts II and IV pray for compensation for use of petitioners' invention prior to issuance of the patent upon different theories. Title 28, U. S. Code, § 1498 (Appendix, p. 33) provides a remedy for the owner of an inven-

tion against the United States where it has used his invention without license. The owner must own a patent thereon but there is no specific requirement that the patent be in existence at the time of use for compensation to be payable. Ordinarily, the inventor can prevent use during patent pendency by keeping his invention secret, and Patent Office Rule 15 provides that pending applications will be kept secret (Appendix, p. 38); also the inventor may permit use pursuant to agreement to compensate.

Congress, in July 1940, enacted Title 35, U. S. Code § 42 (Appendix, p. 34) which was kept alive by various subsequent enactments (Appendix, p. 35), authorizing the Commissioner of Patents to issue a secrecy order and withhold a patent grant on military inventions and it also provided for compensation from date of use if the inventor subsequently obtained a patent.

It is conceded that no such secrecy order was entered here; however, it is admitted by the motion, that petitioners' bridge enabled *"U. S. Engineers • • • (to) speed tanks and guns across rivers in only a fraction of the time required with the ponderous wood or pontoon bridges of former wars."* (Petition, Count IV, Paragraph 4, R. 10.) It is clear the disclosure of this invention would have been detrimental to the public safety and defense within the meaning of Section 42. It is also an admitted fact that the petitioners' application was preserved in secrecy until July 15, 1947, because the patent was not granted until then, five years after the application was filed.

Shall these petitioners be denied compensation for use of their invention under this statute merely because a formal secrecy order was not entered, in view of their great contribution to the war effort?

The cited statute specifically provides that suit for compensation may be instituted in the Court of Claims, as

petitioners did, and which suit has been erroneously dismissed.

It is also submitted that petitioners are entitled to recover upon a contract implied in fact for use prior to patent issuance, as alleged in Count IV.

The respondent requested that inventions of a military character be submitted directly to its War Department, which admittedly the petitioners did do. That the respondent used this invention in the war prosecution is evidence of its value in spite of General Adams' letter that it was of "no military value." *U. S.* v. *Société,* 224 U. S. 309. The respondent impliedly knew that petitioners expected compensation from the time of submission and compensation was expressly demanded February 3, 1942, less than two months after the initial use; and their property right in the invention was proven by the patent grant July 15, 1947; consequently an implied promise arose to pay for the use. As consideration for this implied promise to pay for use, petitioners submitted their plans and drawings and thus gave up their right to deprive the public of the benefit of their invention by keeping it secret. *Chemical Foundation* v. *General Aniline,* 99 F. (2d) 276 (Certiorari denied 305 U. S. 654).

Where property to which the United States asserts no title is taken for public use, the law implies a contract on which an action may lie in the Court of Claims. *Klebe* v. *U. S.,* 44 Ct. Cl. 58, 263 U. S. 188, 191; *U. S.* v. *Great Falls Mfg. Co.,* 112 U. S. 645; *U. S.* v. *Alexander,* 148 U. S. 186.

Furthermore, there has been a taking of private property for public use without just compensation contrary to Amendment V to our Constitution. The Court of Claims under Title 28, U. S. Code, § 1491 (Appendix, p. 32) is specifically granted jurisdiction of claims against United States arising out of implied contracts or founded upon

the Constitution. The petitioners made a timely filing of their petition in the Court of Claims on April 20, 1953, well within six years of July 15, 1947, when their cause of action became justiciable.

Since the respondent states in its motion for summary judgment that "there is no genuine issue as to any material fact," the petitioners made a countermotion for summary judgment that the alleged fact of respondent's use of petitioners' invention be specified as existing without substantial controversy. Rule 51 (e) of the Court of Claims (Appendix, p. 36) provides this procedure in order to reduce the issues of fact to a minimum prior to trial; the motion was denied.

The Court in *Virginia Shipbuilding Corp.* v. *U. S. Shipping Board*, 292 F. 440, 22 F. (2d) 38 (Certiorari denied 276 U. S. 625), held that a complainant cannot, in the course of the litigation, change its position by claiming rights inconsistent with the allegations of its pleadings to the detriment of the other party. Also a party may be estopped to shift position in respect to infringement. *Allbright-Nell Co.* v. *Autosteam Process Co.*, 70 F. (2d) 959.

The respondent admits it used petitioners' invention at Fort Benning; therefore, the Court of Claims should have certified the fact of infringing use as appearing without substantial controversy.

CONCLUSION.

It is, therefore, respectfully submitted that this petition for writ of certiorari to review the decision of the United States Court of Claims be granted.

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APPENDIX.

TABLE OF CONTENTS.

PAGE

A. Decisions of the Court Below in the Instant Case:
Order of November 3, 1953 (Granting respondent's motion to dismiss Counts II, III and IV) 19
Order of June 8, 1954 (Granting respondent's motion for summary judgment on Count I) ... 24
Order of October 5, 1954 (Denying Petition for Rehearing) 31

B. Federal Statutes which the Case Involves:
44 Stat. 1337 (Day for Taking any Action, etc.) Title 35, § 21, U. S. C. 32
62 Stat. 928 (Court of Claims; Certiorari, Title 28, § 1255, U. S. C.) 32
62 Stat. 940 (Claims against the United States Generally, Title 28, § 1491 U. S. C.) 32
66 Stat. 757 (Patent Cases, Title 28, § 1498, U. S. C.) 33
53 Stat. 1212 (Inventions Patentable, Title 35, § 31 U. S. C.) 33
54 Stat. 710 (Patent: Publication Detrimental to Public Safety or Defense; Compensation for Use of Invention Tendered to United States, Title 35, § 42, U. S. C.) 34
56 Stat. 370 (Extending Life of Title 35, § 42, U. S. C.) 35
66 Stat. 6 (Savings Clause in Act of February 1, 1952, repealing Title 35, § 42 above) 35

66 Stat. 815 (Savings Clause in Act repealing Act of February 1, 1952, above) 35

Constitutional Provisions Applicable:

Amendment V 35

C. Applicable Rule of the Court of Claims:

Rule 10 (c) (Form of pleadings; Exhibits) 36

Rule 51 (Summary Judgment) 36

Applicable Federal Rule of Civil Procedure:

Rule 54 (b) (Judgment upon Multiple Claims) ... 37

Applicable Rule of the Patent Office:

Rule 15 (Pending Applications Kept in Secrecy) . 38

APPENDIX A.

IN THE UNITED STATES COURT OF CLAIMS.

No. 159–53.
(Decided November 3, 1953.)

JAMES J. GEARON, MARY E. GEARON, AND MARY E. GEARON AS EXECUTRIX OF THE ESTATE OF EDWARD GEARON, DECEASED v. THE UNITED STATES.

Mr. Walter F. Boye for the plaintiffs.

Mr. Gordon C. Biddle, with whom was *Mr. Assistant Attorney General Warren E. Burger,* for the defendant. *Mr. Augustus G. Duvas* was on the brief.

ON DEFENDANT'S MOTION TO DISMISS COUNTS II, III, AND IV.

JONES, *Chief Judge,* delivered the opinion of the court:

This is a patent case which is before the court on defendant's motion to dismiss counts II, III, and IV of plaintiffs' petition. The petition was filed April 20, 1953, under the provision of the patent laws of the United States now recodified as Title 28, Section 1498.

The petition alleges that one of the plaintiffs, J. J. Gearon, was the inventor of collapsible military pontoon bridges for which he was issued letters patent No. 2,423,832 on July 15, 1947, on an application filed in the United States Patent Office December 21, 1942.

Under count II of the petition plaintiffs allege unauthorized use of the invention and request reasonable compensation for such unauthorized use during the period

when the application for the patent was pending in the Patent Office.

The Patent Office was established for the fundamental purpose of examining patent applications pending before it against the background of prior art and knowledge, and until this has been done, the fact that there is anything novel or that invention exists cannot be ascertained. Until such examination is completed and a patent issued, the patentee has established no monopoly to an invention. In accordance with the patent statutes, when a patentee is given a monopoly as to his invention, as expressed in the claims of the issued patent, such monopoly is limited to a period of seventeen years. To award compensation for the use of an invention when the application is still pending in the Patent Office in the formative stage would extend the period beyond seventeen years.

There is only one exception to what has been said and that is where publication or disclosure by the grant of a patent might be detrimental to the national security, in which case the Commissioner of Patents shall order that the invention be kept secret and withhold the grant of a patent under certain conditions. (See Sec. 181, 66 Stat. 805.) In such case the patentee, where he receives a patent, may under certain conditions recover from the Government for the use of such invention the right to compensation for such use beginning on the date of the first use of the invention by the Government. Plaintiffs, however, do not plead the issuance of such a secrecy order in the present case.

Count II of the petition which requests compensation for the unauthorized use of an unpatented invention should be dismissed.

Count III of the petition requested this court to determine the amount of reasonable compensation for future use of the patent throughout its life up to and in-

cluding the date of July 15, 1964, and as an alternative to determine the price or consideration for the sale of the patent to the defendant. It is unnecessary, however, to consider this count of the petition, for plaintiffs in their reply brief have agreed that defendant's motion to dismiss count III may be granted.

Plaintiffs originally based count IV of the petition on the provisions of United States Code, Title 28, Sec. 1491, and of the Federal Tort Claims Act of August 2, 1946, United States Code, Title 28, Sec. 2674. Plaintiffs, however, in their reply brief now state as follows:

> Plaintiffs make no contention that this Court has original jurisdiction of cases founded in tort; nor of cases predicated on contracts implied in law rather than implied in fact.
>
> But Count 4 makes allegations which spell out a contract implied in fact. In paragraph 4 it is alleged that the defendant by its Department of Defense and War Department used said invention; in paragraph 5, page 11, that defendant utilized and used said invention with profit and benefit to the defendant, and without resulting compensation or emolument or benefit whatever to the plaintiffs.

The allegations which plaintiffs depend upon in connection with count IV in brief are that early in 1940, after an appeal by the Government by newspapers and radio, to submit plans of inventions of a military character to the War Department and not file the same in the Patent Office, James J. Gearon submitted certain drawings and specifications for pontoon bridges to the Engineer Procurement District of Chicago, Illinois. These were acknowledged under date of August 14, 1940, and Gearon was advised that such data should be submitted to the Chief of Engineers, United States Army, Washington, D. C., which he did. The War Department notified Gearon by a letter dated September 5, 1940, as follows, which letter is attached to plaintiffs' petition as plaintiffs' exhibit 3:

War Department
The Adjutant General's Office
Washington

SEPTEMBER 5, 1940.

In Reply
Refer To AG 070 (8-15-40)M
Subject: Invention Improved Military Pontoon Bridge

To: Mr. James J. Gearon,
4523 West Adams St.,
Chicago, Ill.

DEAR SIR: I am requested by the Secretary of War to state that your proposal on the subject above mentioned has been carefully examined, and it is found that the device does not possess sufficient value for military purposes to warrant further consideration by the War Department.

It is desired to thank you for your interest in submitting the proposal for examination.

Very truly yours,
(Signed) E. S. ADAMS,
Major General,
The Adjutant General.

3 Incl.

On February 3, 1942, plaintiff Gearon submitted drawings and a description of his unpatented invention to The National Inventors Council, Washington, D. C. On May 4, 1942, The Inventors Council directed a letter to plaintiff Gearon, which is also attached to plaintiffs' petition, as plaintiffs' exhibit 7, this letter reading as follows:

> A careful examination of the above identified proposal discloses that the suggestion is not of such character as may be employed in the war effort at the present time.
>
> Please accept our thanks for the patriotic spirit shown in forwarding the material for examination. You may be sure that our technical staff will be glad to examine any and all future ideas which you may care to submit.

The plaintiffs further allege that after they had supplied the Government with drawings and descriptions of the Gearon unpatented invention, according to numerous magazine articles and publications, the names of which are given, the Government was able to build a better pontoon bridge in less time than formerly, and that this occurred both prior to and subsequent to July 15, 1947, the date of issuance of the letters patent now in suit. In so far as any unauthorized use by the Government occurred subsequent to the issuance of the patent, plaintiffs are entitled to present proof of such acts under United States Code, Title 28, Sec. 1498, upon which count I of the petition is based, but the facts alleged are not sufficient to show the existence of a contract, express or implied in fact, between the Government and Gearon for the payment of compensation for the information and data submitted by him. No one having authority to bind the United States by contract promised to pay plaintiffs compensation for the information submitted or for the use of the unpatented devices described therein. The correspondence set out above and which was filed as a part of the petition is indicative of the nonacceptance of the Gearon pontoon bridge.

It is the opinion of the court that counts II, III, and IV do not set forth any cause of action over which the court has jurisdiction. The defendant's motion to dismiss these counts is therefore sustained and counts II, III, and IV of the petition are dismissed.

It is so ordered.

MADDEN, *Judge;* WHITAKER, *Judge;* and LITTLETON, *Judge,* concur.

IN THE UNITED STATES COURT OF CLAIMS.

No. 159-53.
(Decided June 8, 1954.)

JAMES J. GEARON, MARY E. GEARON, AND MARY E. GEARON AS EXECUTRIX OF THE ESTATE OF EDWARD GEARON, DECEASED v. THE UNITED STATES.

Mr. Walter F. Boye for the plaintiffs. *Messrs. Donald M. Reno* and *Smith, Ristig & Smith,* were on the brief.

Mr. Eugene R. Weisbender, with whom was *Mr. Assistant Attorney General Warren E. Burger,* for the defendant.

ON PLAINTIFFS' AND DEFENDANT'S MOTIONS FOR SUMMARY JUDGMENT.

JONES, *Chief Judge,* delivered the opinion of the court:

Defendant's motion for summary judgment urges dismissal of the petition herein on the grounds that the patent on which the suit is based is void in view of a statutory bar. This will first be considered.

The petition alleges that one of the plaintiffs, James J. Gearon, was the inventor of inflatable, collapsible, military pontoon bridges for which he was issued letters patent No. 2,423,832 on July 15, 1947, on an application filed by Gearon in the United States Patent Office December 21, 1942.

As originally filed on April 20, 1953, the petition contained four counts. On May 20, 1953, the defendant filed a motion to dismiss counts II, III, and IV of the petition as not setting forth any cause of action over which the court has jurisdiction. This motion was sustained in an

opinion of the court November 3, 1953, and these counts were dismissed.

The remaining count, count I, is under the provision of the patent laws of the United States, now recodified as 28 U. S. C. 1948, which provides for suits in this court for the unlicensed use or manufacture by or for the United States of a patented invention.

The petition sets forth certain facts substantiated by references to various publications as to the use and publication of the Gearon invention prior to the filing in the Patent Office of the application that materialized into the patent in suit. These are contained in count IV of the petition. Because of their pertinency to the present issue, we quote from the petition:

> * * * that heeding the said proper and patriotic appeals, said James J. Gearon, inventor of said patent, submitted, or caused to be submitted, his invention, including drawings and specifications, for Inflatable, Collapsible Pontoon Bridges to the Engineering Procurement District of Chicago, Illinois, and under date of August 7, 1940 receipt was acknowledged by said office by letter, * * *.
>
> * * * that under date of December 19, 1941, the Associated Press covered a dispatch as follows:
>
> "United States Army engineers yesterday threw a 315 foot pontoon bridge across the Chattahoochin [*sic*] river in 2 hours and 6 minutes. This was one hour less than the previous record for a similar span. Col. L. E. Oliver, armored force engineering officer, said the bridge was a radically new design, utilizing rubber balloon pontoons that support two steel treadways. Because of the new bridge strength, 20 ton tanks can cross it at a fair speed, and 12 ton tanks can step it up even faster. There is no speed limit for trucks. Its construction requires only half the number of men needed for old type bridges."
>
> • • • • •
>
> That photographs of the various pontoon bridges

showing use of the invention were contained in various publications, including Life Magazine of December 7, 1942, Life Magazine of December 20, 1943, the Chicago Tribune of December 20, 1941, and that in contrast the Military Engineer in the September-October, 1940, issue, page 362, showed photographs of the old pontoon bridge, which, apparently, was the best pontoon bridge that the defendant knew of or utilized prior to said invention of said plaintiff.

* * * * *

These assertions were solemnly sworn to by the plaintiffs, including the plaintiff-patentee. An inventor's apprisal of his own invention must necessarily be important. Unless these sworn assertions are challenged or rebutted by the defendant, which defendant has not done, they must be accepted as proved. (See *John Stub* v. *The United States*, No. 478-53, decided March 2, 1954, and cases cited therein.) While the *Stub* case dealt with the acceptance as true of uncontroverted statements in affidavits, the same reasoning is equally applicable to sworn statements of fact in the petition if uncontroverted.

Summarizing the above statements in the petition, the Gearon invention, including drawings and specifications, was submitted to the Government in 1940, and a use of the invention was illustrated and described in a printed publication, *i. e.*, The Chicago Tribune, on December 20, 1941.

Reference is next made to the prosecution of the Gearon application which materialized into the patent in suit.

An application for a patent comprises the following parts:

(1) A written petition;

(2) A written description or specification of the invention, together with a claim or claims, and a drawing where the nature of the case admits;

(3) An oath;

(4) A filing fee.

Applications and proceedings on applications are primarily governed by the provisions of the Revised Statutes. Where these provisions do not cover a particular point, that point is governed by the rules of the Patent Office. Every such rule, unless it is inconsistent with law, is as authoritative as the Revised Statutes. An application is not given a filing date or taken up for examination until all of the above enumerated parts thereof have been filed.

Defendant has attached to its motion as exhibit A a certified copy of pertinent portions of the contents of the Gearon file wrapper which is a public record in the Patent Office. As shown in this record, Gearon on October 1, 1942, forwarded to the Patent Office two sheets of drawings and five sheets of specifications and description of a military pontoon bridge which he stated was his invention, together with a filing fee. His letter of transmittal included the following statement:

> These drawings and specifications and the description are in the original form from which I made copies, and in June, 1940 submitted them to officers of the United States Army, Department of Engineers.

This letter and enclosures were received by the Patent Office on October 3, 1942, and receipt was acknowledged by the Commissioner of Patents in a letter of October 7, 1942, notifying Gearon that the application was incomplete and would be given a filing date as of the date the petition and oath were received. Blank forms for these were forwarded to Gearon in this letter.

On December 19, 1942, Gearon signed the petition and executed the oath before a notary public and forwarded these documents to the Patent Office. These papers were re-

ceived at the Patent Office on December 21, 1942, and the Patent Office accepted the application as filed complete on that date and so endorsed the file wrapper.

We proceed next to the patent statute, which is controlling in the present situation, R. S. 4886, Title 35, § 31, U. S. Code (1940 Ed.) in force at the time of the filing and prosecution of the application resulting in the patent here in suit and which was as follows:

> Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, * * * *not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application,* unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. [Italics supplied.]

Attention is directed to the exhaustive opinion in *Lorenz et al.* v. *Colgate-Palmolive-Peet Co.*, 167 F. 2d 423, 429-430, which refers in detail to numerous other cases on the subject matter of this statute. This opinion summarizes this same situation in the following phraseology, except that it has reference to a prior use rather than to a prior publication:

> * * * The prior-public-use proviso of R. S. § 4886 was enacted by Congress in the public interest. It contains no qualification or exception which limits the nature of the public use. We think that Congress intended that if an inventor does not protect his discovery by an application for a patent within the period prescribed by the Act, and an intervening public use arises from any source whatsoever, the in-

ventor must be barred from a patent or from the fruits of his monopoly, if a patent has issued to him. There is not a single word in the statute which would tend to put an inventor, whose disclosures have been pirated, in any different position from one who has permitted the use of his process. * * * isolated instances of injustice may result if the law be strictly applied, but the inventor's remedy is sure. He is master of the situation and by prompt action can protect himself fully and render the defense of prior public use impossible: "If [the inventor] fails to take so simple and reasonable a precaution why should it not be said that the risk is his own and that he cannot complain of the consequences of his own supineness?" Moreover, it is apparent that if fraud or piracy be held to prevent the literal application of the prior-public-use provision a fruitful field for collusion will be opened and the public interest which R. S. § 4886 is designed to protect will suffer. While we cannot fail to view Lorenz's predicament with sympathy, we may not render our decision on such a basis. For these reasons, we hold, as did the court below, that the Lorenz patent is void by reason of prior public use.

It should be pointed out that the two-year statutory period discussed in this cited case was by act of Congress changed to a one-year statutory period under date of August 5, 1939.

The publication in The Chicago Tribune on December 20, 1941, sworn to by the plaintiffs as showing the use of the Gearon invention, was more than one year prior to the completion of the Gearon application in the Patent Office, and the patent is therefore unenforceable because of this statutory bar.

For the reasons stated, defendant's motion for summary judgment is granted.

Plaintiff's counter-motion is made pursuant to and predicated upon defendant's motion for summary judg-

ment in which certain facts therein are asserted to be true. Plaintiffs, stating that certain material facts exist without substantial controversy, request an order specifying in substance that manufacture and use after the issuance of the Gearon patent in suit by the Government constitutes an infringement of such patent.

Plaintiffs' theory appears to be that if it is an uncontroverted fact that the Government used the Gearon invention prior to the issuance of the patent in suit, if the same structure were made or used after the issuance of the Gearon patent, it would constitute an infringement. Plaintiffs urge that "the strict issue of infringement is fixed;—the same structure is equally applicable for purpose of anticipation or as infringement." This is apparently based upon the patent adage, "That which infringes, if early enough, anticipates."

Such order as plaintiffs request of course cannot be entered. In the first place, during the interim between the uncontroverted use of plaintiffs' invention in 1941 and the issuance of the Gearon patent on July 15, 1947, the defendant may well have changed, altered or otherwise modified its pontoon bridge structure. And, secondly, assuming that no change in the Government structure was made, the Gearon patent, as stated, *supra,* is unenforceable because of the statutory bar. There can be no infringement of an invalid patent.

Plaintiffs' counter-motion is denied.

Defendant's motion for summary judgment having been sustained and plaintiffs' motion having been denied, the petition is dismissed.

It is so ordered.

MADDEN, *Judge;* WHITAKER, *Judge;* and LITTLETON, *Judge,* concur.

Judge LARAMORE took no part in the consideration or decision of this case.

IN THE UNITED STATES COURT OF CLAIMS.

No. 159-53.
(Decided October 5, 1954)

JAMES J. GEARON, ET AL.,

vs.

UNITED STATES.

ORDER.

These cases come before the Court on motions for rehearings, amendment of judgments or new trials under Rule 53 and 54 of the Rules of this Court and, on consideration thereof,

IT IS ORDERED this fifth day of October, 1954, that said motions be and the same are overruled.

By the Court:

/s/ MARVIN JONES,

Chief Judge.

APPENDIX B.

Day for Taking Any Action or Paying Any Fee Falling on Sunday.

Where the day, or the last day fixed by statute for taking any action or paying any fee in the United States Patent Office falls on Sunday, or on a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

Title 35, United States Code, 1940 Edition, Section 21 (March 2, 1927, Chap. 273, Section 14, 44 Stat. 1337).

Court of Claims; Certiorari.

Cases in the Court of Claims may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted on petition of the United States or the claimant;

Title 28, Section 1255, United States Code, 1952 Edition, p. 4182 (June 25, 1948, Chap. 646, Section 1, 62 Stat. 928).

Claims Against the United States Generally.

The Court of Claims shall have jurisdiction to render judgment upon any claims against the United States;

(1) founded upon the Constitution; or
(2) founded upon any Act of Congress, * * *;
(4) founded upon any express or implied contract with the United States;

Title 28, Section 1491, United States Code, 1952 Edition, p. 4204 (June 25, 1948, Chap. 646, Section 1, 62 Stat. 940).

PATENT CASES.

Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by action against the United States in the Court of Claims for the recovery of his reasonable and entire compensation for such use and manufacture.

Title 28, Section 1498, United States Code, 1952 Edition, p. 4205 (July 17, 1952, Chap. 930, Section 1, 66 Stat. 757).

INVENTIONS PATENTABLE.

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, * * * not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

Title 35, Section 31, United States Code, 1940 Edition, p. 3161 (August 5, 1939, Chap. 450, Section 1, 53 Stat. 1212).

PATENTS: PUBLICATION DETRIMENTAL TO PUBLIC SAFETY OR DEFENSE; COMPENSATION FOR USE OF INVENTION TENDERED TO UNITED STATES.

Whenever the publication or disclosure of an invention by the granting of a patent might, in the opinion of the Commissioner of Patents, be detrimental to the public safety or defense he may order that the invention be kept secret and withhold the grant of a patent for such period or periods as in his opinion the national interest requires: Provided, That the invention disclosed in the application for said patent may be held abandoned upon it being established before or by the Commissioner that in violation of said order said invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor or his assigns or legal representatives, without the consent or approval of the Commissioner of Patents.

When an applicant whose patent is withheld as herein provided and who faithfully obeys the order of the Commissioner of Patents above referred to shall tender his invention to the Government of the United States for its use, he shall, if and when he ultimately receives a patent, have the right to sue for compensation in the Court of Claims, such right to compensation to begin from the date of the use of the invention by the Government: Provided, That the Secretary of War or the Secretary of the Navy or the chief officer of any established defense agency of the United States, as the case may be, is authorized to enter into an agreement with the said applicant in full settlement and compromise for the damage accruing to him by reason of the order of secrecy, and for the use of the invention by the Government.

Title 35, Section 42, United States Code, 1940 Edition, p. 3164 (July 1, 1940, Chap. 501, Section 1, 54 Stat. 710).

AN ACT

To amend the Act relating to preventing the publication of inventions in the national interest, and for other purposes.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That Section 2 of the Act of Congress approved July 1, 1940 (Public, Numbered 700, Seventy-sixth Congress, third session, Ch. 501) be amended to read as follows:

> "Section 2. This Act shall take effect on approval and, together with the provisions of the Act of August 21, 1941 (Public Law 239, Seventy-seventh Congress, first session, Ch. 393), shall remain in force during the time when the United States is at war."
>
> Approved June 16, 1942.
>
> Chap. 415, Public Laws 56 Stat. 370.

Act of Congress approved February 1, 1952, Chapter 4, 66 Stat. 6, Section 10, repealing former Sections 42-42(f) of Title 35, provided in part:

> "A claim arising under the repealed acts and unsettled as of the effective date of this Act may be presented and determined pursuant to the provisions of this Act."

Act of Congress approved July 15, 1952, Chapter 950, Section 5, 66 Stat. 815, Section 4 (b), repealing the Act of February 1, 1952, provided in part:

> "A claim arising under the repealed acts and unsettled as of the effective date of this Act may be presented and determined pursuant to the provisions of this Act."

AMENDMENT V TO UNITED STATES CONSTITUTION.

No person shall be * * * deprived of * * * property without due process of law; nor shall private property be taken for public use, without just compensation.

APPENDIX C.

Rule 10. Form of Pleadings.

(c) Adoption by Reference; Exhibits; * * * A copy of any written instrument which is an exhibit to a pleading is a part thereof for all purposes unless otherwise indicated.

Rules of the United States Court of Claims.

Rule 51. Summary Judgment.

(a) For Claimant: A party seeking to recover upon a claim or counterclaim may, at any time (except as provided in subsection (c) below) after a responsive pleading has been filed (including the service of a motion for summary judgment by the adverse party) move with or without supporting affidavits for a summary judgment in his favor upon all or any part thereof.

(b) For the Defending Party: A party against whom a claim or counterclaim is asserted may, at any time (except as provided in subsection (c) below), move with or without supporting affidavits for a summary judgment in his favor as to all or any party thereof.

(d) Motion and Proceedings Thereon: * * * The judgment sought shall be rendered if the pleadings, depositions and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. A summary judgment may be rendered on the issue of liability alone although there is a genuine issue as to the amount of damages.

(e) Case Not Fully Adjudicated on Motion: If on motion under this rule judgment is not rendered upon the

whole case or for all the relief asked and a trial is necessary, the Court at the hearing of the motion, by examining the pleadings and the evidence before it and by interrogating counsel, shall, if practicable, ascertain what material facts exist without substantial controversy and what material facts are actually in good faith controverted. It shall thereupon make an order specifying the facts that appear without substantial controversy, including the extent to which the amount of damages or other relief is not in controversy, and directing such further proceedings in the action as are just. Upon the trial of the action the facts so specified shall be deemed established, and the trial shall be conducted accordingly.

Rules of the United States Court of Claims.

RULE 54. (b) JUDGMENT UPON MULTIPLE CLAIMS.

When more than one claim for relief is presented in an action, whether as a claim, counterclaim, cross-claim, or third-party claim, the court may direct the entry of a final judgment upon one or more but less than all of the claims only upon an express determination that there is no just reason for delay and upon an express direction for the entry of judgment. In the absence of such determination and direction, any order or other form of decision, however designated which adjudicates less than all the claims shall not terminate the action as to any of the claims, and the order or other form of decision is subject to revision at any time before the entry of judgment adjudicating all the claims.

Title 28, Section 2072, United States Code, 1952 Edition, p. 4337 Federal Rules of Civil Procedure.

RULE 15. PENDING APPLICATIONS KEPT IN SECRECY.

Pending applications are preserved in secrecy. No information will be given, without authority, respecting the filing by any particular person or an application for a patent or for the reissue of a patent, the pendency of any particular case before the office, or the subject matter of any particular application, unless it shall be necessary to the proper conduct of business before the office.

Rule 15 of Patent Office Rules.

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INDEX

	Page
Opinions below	1
Jurisdiction	2
Questions presented	2
Statutes involved	3
Statement	3
Argument	7
Conclusion	22
Appendix	23

CITATIONS

Cases:

Ackermans v. *General Motors Corp.*, 202 F. 2d 642, certiorari denied, 345 U.S. 996	19
Andrews v. *Hovey*, 123 U.S. 267, opinion denying rehearing, 124 U.S. 694	7, 12, 13
A. Schrader's Sons, Inc. v. *Wein Sales Corp.*, 9 F. 2d 306	11, 14
Bertram, In re, 88 F. 2d 834	12, 15
Bocz v. *Hudson Motor Car Co.*, 19 F. Supp. 385	11
Campbell v. *City of New York*, 35 Fed. 504	18
Crozier v. *Krupp*, 224 U.S. 290	19
DeFilippis v. *Chrysler Corp.*, 53 F. Supp. 977, affirmed, 159 F. 2d 478, certiorari denied, 331 U.S. 848	19
De Forest Co. v. *United States*, 273 U.S. 236	21
Donaldson, In re, 138 F. 2d 419	7
Eastman v. *Mayor, etc. of New York*, 134 Fed. 844,	9, 12, 14
Eckert v. *Braun*, 155 F. 2d 517	19
Egbert v. *Lippmann*, Fed. Case No. 4306, 8 Fed. Cas. 370, affirmed, 104 U.S. 333	8, 11
Electric Battery Co. v. *Shimadzu*, 307 U.S. 5	12
Fulmer v. *United States*, 83 F. Supp. 137	20
Henry v. *Francetown Soap-Stone Co.*, 2 Fed. 78	8, 18
Horner v. *United States*, 114 C. Cls. 612, certiorari denied, 338 U.S. 956	21

Cases—Continued

	Page
Incomplete Application Filed Oct. 9, 1942, In re, 56 U.S.P.Q. 187	18
J. R. Clark Co. v. *Murray Metal Products Co.*, 114 F. Supp. 224	11
Josserand, Application of, 188 F. 2d 486	12
Land v. *Dreyer*, 155 F. 2d 383	17
Lorenz v. *Colgate-Palmolive-Peet Co.*, 167 F. 2d 423	9, 12, 13
Martin v. *Wyeth, Inc.*, 96 F. Supp. 689, affirmed, 193 F. 2d 58	12
Midland Flour Milling Co. v. *Bobbitt*, 70 F. 2d 416	15
Nuss v. *United States*, 117 F. Supp. 413	12
Patton v. *United States*, 110 C. Cls. 195	19, 21
Robbins v. *United States*, 106 C. Cls. 278	19
Rodman Chemical Co. v. *United States*, 65 C. Cls. 39	19, 20, 21
Russell v. *United States*, 182 U.S. 516	21
Schillinger v. *United States*, 155 U.S. 163	21
Shaw v. *Cooper*, 7 Pet. 292	9
Smith & Griggs Mfg. Co. v. *Sprague*, 123 U.S. 249	12, 14, 15
Stolte v. *Larkin*, 110 F. 2d 226	11
Todd v. *Sears, Roebuck & Co.*, 119 F. Supp. 38	17
Twyman v. *Radiant Glass Co.*, 56 F. 2d 119	12
United Foundation Corp. v. *United States*, C. Cls. No. 175-52, decided Jan. 11, 1955	18
United States v. *Causby*, 328 U.S. 256	21
United States v. *General Motors Corp.*, 323 U.S. 373	21
United States v. *Kansas City Ins. Co.*, 339 U.S. 799	21
Wailes Dove-Hermiston Corp. v. *Oklahoma Contracting Co.*, 48 F. 2d 901, affirmed, 56 F. 2d 143	17
White v. *Mechanics Securities Corp.*, 269 U.S. 283	11

Constitution of the United States:

Fifth Amendment	21

Statutes:

	Page
Act of August 5, 1939, 53 Stat. 1212, c. 450	7
5 Stat. 354 (1839)	7
66 Stat. 3	20
28 U.S.C. 1491	20, 23
28 U.S.C. 1498	6, 19, 23
28 U.S.C. 2101(c)	18
28 U.S.C. 2501	21, 23
35 U.S.C. 6 (1946 Ed.)	17, 24
35 U.S.C. 21 (1946 Ed.)	16, 24
35 U.S.C. 31 (1946 Ed.)	7, 8, 15, 16, 17, 24
35 U.S.C. 42 (1946 Ed.)	20, 25
35 U.S.C. 69 (1946 Ed.)	7, 25
35 U.S.C. 102 (1952 Ed.)	7
35 U.S.C. 111 (1952 Ed.)	17, 26
35 U.S.C. 181-183 (1952 Ed.)	20
35 U.S.C. 282 (1952 Ed.)	7

Miscellaneous:

37 C.F.R. Sec. 1.30 (1939 Ed.)	16, 27
37 C.F.R. Sec. 1.31 (1939 Ed.)	16, 27
Rules of the Court of Claims of the United States (1953):	
Rule 50	18
Rule 57(a)	18
Rules of Practice in the United States Patent Office, 1925 Edition:	
Rules 30 and 31	17
E. J. Stoddard, *Annotated Rules of Practice in the United States Patent Office* (1920), p. 803, Rule 28	17
2 Walker on *Patents*, Sec. 147 (Deller's Ed. 1937).	17

In the Supreme Court of the United States

OCTOBER TERM, 1954

No. 500

JAMES J. GEARON, MARY E. GEARON, AND MARY E. GEARON, AS EXECUTRIX OF THE ESTATE OF EDWARD GEARON, DECEASED, PETITIONERS

v.

THE UNITED STATES

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

BRIEF FOR THE UNITED STATES IN OPPOSITION

OPINIONS BELOW

The opinion of the Court of Claims dismissing counts 2, 3 and 4 of petitioners' complaint (Pet. App. A, pp. 19-23), is reported at 115 F. Supp. 910. The opinion of the Court of Claims granting the Government's motion for summary judgment on the remaining count 1, and dismissing the complaint (Pet. App. A, pp. 24-30) is reported at 121 F. Supp. 652.

JURISDICTION

The judgment of the Court of Claims dismissing counts 2, 3 and 4 was entered November 3, 1953 (Pet. App. p. 23). The order of the court below granting summary judgment on count 1 and dismissing the petition was entered on June 8, 1954 (Pet. App. p. 30). A petition for rehearing on the motions for summary judgment was overruled on October 5, 1954 (Pet. App. p. 31). The petition for a writ of certiorari was filed on December 31, 1954. The jurisdiction of this Court is sought to be invoked under 28 U. S. C. 1255(1).

QUESTIONS PRESENTED

1. Whether a patent is shown to be invalid under 35 U. S. C. (1946 ed.)31 [1] where, in a suit to recover for the alleged unauthorized use by the Government of an invention covered by the patent, the patent owners assert as support for their claims the disclosure in a newspaper publication, more than a year prior to the date on which the patent application was filed, of governmental use of the invention.

2. Whether the alleged public use of an invention by the United States, to whom the inventor had offered it for use in the national defense, invalidates a patent applied for more than one year after the alleged use.

3. Whether a patent is invalid because of publi-

[1] Unless otherwise noted, the citations of the provisions of 35 U.S.C. are to the 1946 Edition of the Code. These provisions were the same as those in effect during the period in which this case arose.

cation or public use occurring more than one year before the completion of the application, where the inventor submitted drawings, specifications and the statutory fee in time, but the Patent Office did not accept the application for filing until the executed petition and oath had been submitted, which was more than a year after the alleged publication or public use.

STATUTES INVOLVED

The relevant provisions of Titles 28 and 35, United States Code and of the regulations of the Patent Office are set forth in the Appendix, *infra*, pp. 23-27.

STATEMENT

This suit seeks to recover for the allegedly unauthorized use by the United States of petitioner James J. Gearon's invention, an inflatable, collapsible military pontoon bridge on which Patent No. 2,423,832 was issued July 15, 1947.[2] The facts in the case may be summarized as follows:

In August 1940, Gearon submitted his alleged invention to the War Department (Pet. C. C. Exh. 1, p. 14; Res. Mot. Exh. B, p. 53).[3] By letter dated September 5, 1940, the Adjutant General informed

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[2] As a result of various assignments, the patent is now owned by petitioners.

[3] The record herein consists of the petition filed in the Court of Claims together with the exhibits thereto, and motion papers, together with the exhibits thereto. For convenience, the petition in the Court of Claims will be referred to as "Pet. C.C.", the exhibits thereto as "Pet. C.C. Exh.", and the government's motion-for-summary-judgment exhibits as "Res. Mot. Exh."

him that the alleged invention had been examined but found not to possess sufficient value for military purposes to warrant further consideration by the War Department (Pet. C. C. Exh. 3, p. 15; Res. Mot. Exh. B, p. 56).

Through an Associated Press dispatch dated December 19, 1941 which was published in the Chicago Tribune the following day, Gearon learned that on December 18, 1941 the United States Army Engineers had used a military pontoon bridge "of radically new design", and allegedly learned that the bridge so used embodied his submitted invention. (Pet. C. C. Exh. 5, p. 17; Res. Mot. Exh. B, p. 49). Thereafter in February 1942 Gearon wrote the National Inventors Council, Department of Commerce,[4] asserting that a military pontoon bridge "designed, constructed and assembled in almost exact accordance with the drawings and descriptions of my invention which I had submitted" was "given a test" by Army Engineers at Fort Benning, Georgia, in December 1941, and requesting the Council "to investigate my claim for compensation for its use by the United States Government" (Pet. C. C. Exh. 5, p. 17). On May 4, 1942, the National Inventors Council informed Gearon by letter that his suggestion was "not of such character as may be employed in the war effort at the present time"; this letter made no reference to his request with respect to compensa-

[4] In response to a letter received from Gearon in January 1942, the Adjutant General had referred Gearon to the National Inventors Council (Pet. C.C. Exh. 4, p. 16).

tion for use of his invention (Pet. C. C. Exh. 7, p. 19; Res. Mot. Exh. B, p. 58).

Gearon then undertook to apply for a patent (Pet. C. C. Exh. 8, p. 20). On October 1, 1942, he mailed drawings, specifications and description of his invention, in addition to the statutory filing fee, to the Commissioner of Patents (Res. Mot. Exh. A, pp. 36, 37). The Patent Office acknowledged receipt of these documents but advised Gearon that they could not be given a filing date or placed among the applications for examination until the required petition and oath, signed and sworn to, were submitted, and that the filing date would be the date of their receipt (Res. Mot. Exh. A, p. 39). Gearon executed and mailed the petition and oath on December 19, 1942 (Res. Mot. Exh. A, pp. 40, 41, 42). These were received by the Patent Office on December 21, 1942, which was the filing date accorded Gearon's application (Res. Mot. Exh. A, pp. 36, 40, 41, 42).[5] Subsequently on July 15, 1947, the Patent Office issued Patent No. 2,423,832 on Gearon's invention.

In their petition filed in the Court of Claims on April 20, 1953, petitioners alleged that the Associated Press dispatch and other articles, pictures, descriptions and accounts in newspapers and magazines substantiated their information and belief that the War Department and the Department of Defense used the invention, and that photographs

[5] Supplemental oaths filed by Gearon in the Patent Office on August 9, 1943, and July 14, 1945, recognized that his application was filed on December 21, 1942 (Res. Mot. Exh. A, pp. 43, 44).

showing use of their invention were contained in various publications, including the Chicago Tribune of December 20, 1941 (Pet. C. C. pp. 9-10).

The petition contained four counts. Count 1 sought compensation, under 28 U. S. C. 1498 *infra*, p. 23, for the use of the patented invention. Count 2 sought compensation, under 28 U. S. C. 1498, for use of the invention prior to the issuance of the patent. Count 3 sought reasonable compensation for future use during the life of the patent. Count 4 alleged disclosure of the invention by Gearon to the United States, and its unauthorized use thereof resulting in unjust enrichment and taking of property; according to petitioners, they thereby sought compensation on the theory of breach of an implied contract and a taking of property under the Fifth Amendment.

On November 3, 1953, the Court of Claims granted the Government's motion to dismiss counts 2, 3 and 4 for failure to state a claim (Pet. App. A, pp. 19-23). Petitioners agreed to the dismissal of count 3 and now seek no relief with respect to it. On June 8, 1954, the Court of Claims granted respondent's motion for summary judgment on count 1 and dismissed the petition (Pet. App. A, pp. 24-30). The court found that the use by the Government of Gearon's invention, as alleged in the petition, had occurred more than one year prior to the filing of petitioner Gearon's application for a patent and held that petitioners' claim under 28 U. S. C. 1498, was therefore barred.

A petition for rehearing on the motions for summary judgment was overruled on October 5, 1954.[6]

ARGUMENT

1. *Count 1 of the Petition in the Court of Claims.* 35 U. S. C. 31, *infra*, pp. 24-25, upon which the court below relied in rendering summary judgment against petitioners on Count 1 and dismissing the petition, provided that a valid patent might be granted to an inventor only if his claimed invention was "not * * * described in any printed publication * * * more than one year prior to his application [for a patent], and not in public use or on sale in this country for more than one year prior to his application" for such patent.[7] 35 U. S. C. 69 *infra*, pp. 25-26, provided that, upon pleading the general issue, the defendant might prove in defense to an action for infringement the above-quoted matters set forth in 35 U. S. C. 31 which render the patent invalid.[8]

Petitioners seek to attack the summary judgment

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[6] A motion for leave to file a second petition for rehearing was filed on December 30, 1954, one day before the petition for a writ of certiorari was filed, which was denied by the court below on January 7, 1955. See fn. 12, *infra*, p. 16.

[7] Prior to August 5, 1940 (Act of August 5, 1939, 53 Stat. 1212, c. 450), the time period for prior publication, public use, or sale which would invalidate a patent was two years. See *In re Donaldson*, 138 F. 2d 419 (C.C.P.A.). Similar invalidating provisions have appeared in the statute since 1839. See 5 Stat. 354; *Andrews* v. *Hovey*, 123 U.S. 267, 271-275.

[8] The corresponding sections of the 1952 patent code are 35 U.S.C. 102, 282.

and dismissal entered by the court below on various grounds, *viz.*, by questioning the invalidating effect of the "publication," the "public use", and the untimeliness of the inventor's application for his patent, as well as by arguing that the limitations in 35 U. S. C. 31 do not apply at all to their case because the invention was disclosed to the Government in confidence. Their contentions are without merit.

(a) *The Statute.* In enacting the provisions set forth in 35 U. S. C. 31, Congress plainly intended to take away the right to obtain a patent after an invention has been in public use or otherwise available to the public for a specified period, in this case one year. *Andrews* v. *Hovey,* 123 U. S. 267, 274. Once the public has received the opportunity to exploit an invention, the inventor must act expeditiously to protect and establish a monopoly. The time bar fixed is necessarily a "peremptory consequence imposed by the statute" in furtherance of sound policy. *Egbert* v. *Lippmann,* Fed. Cas. No. 4306, 8 Fed. Cas. 370 (S. D. N. Y.), affirmed, 104 U. S. 333; *Henry* v. *Francestown Soap-Stone Co.,* 2 Fed. 78, 81-82 (C. C. D. N. H.). The line must be drawn somewhere and abided by, even though the inevitable result is that those who miss by a day or an hour can make out a superficially appealing case for an exception. But as this Court long ago observed, "A strict construction of the act, as regards the public use of an invention, before it is presented, is not only required by its letter and spirit, but also by sound policy. A term of fourteen years was deemed sufficient for the en-

joyment of an exclusive right of an invention by the inventor; but if he may delay an application for his patent, at pleasure, although his invention be carried into public use, he may extend the period beyond what the law intended to give him." *Shaw* v. *Cooper*, 7 Pet. 292, 321-322.

At various points in their petition for a writ of certiorari (Pet. pp. 11, 13-14, 15), petitioners, in effect, request a relaxation of the statute and object to "strict formalism." But even if relaxation might be appropriate, petitioners do not make out a case for it here. Petitioners concededly knew of the prior public use and publication soon after they occurred. Consequently, the only possible reason for failure to make timely application is petitioners' own procrastination. The language in *Eastman* v. *Mayor, etc., of New York*, 134 Fed. 844, 854 (C. A. 2d) is particularly appropriate here: "The inventor is master of the situation and has it in his power by prompt action to make the defense of prior public use impossible. * * * if he fails to take so simple and reasonable a precaution, why should it not be said that the risk is his and that he cannot complain of the consequences of his own supineness?" See also *Lorenz* v. *Colgate-Palmolive-Peet Co.*, 167 F. 2d 423, 429, 430 (C. A. 3).

(b) *Publication.* The Court of Claims held that petitioners' patent was invalid because of the "publication in The Chicago Tribune on December 20, 1941, sworn to by the plaintiffs as showing the use of the Gearon invention" (Pet. App. A, p. 29). Referring to the Associated Press dispatch (Pet. C. C. p. 9) on which the Chicago Trib-

une article was based, petitioners contend that this publication is insufficient to invalidate the patent, because it was not sufficiently descriptive of their invention. However, as the opinion below makes clear, the holding that publication had occurred was not grounded on the newspaper dispatch alone but rather on "publication in The Chicago Tribune on December 20, 1941, *sworn to by the plaintiffs as showing the use of the Gearon invention*" (emphasis added).

Petitioners asserted that their information and belief that the United States had used their invention before the issuance of the patent was "fostered and substantiated" by various newspaper and magazine publications, and they set forth the Chicago Tribune dispatch as an instance thereof (Pet. C. C. p. 9). Petitioners further alleged that "photographs of the various pontoon bridges showing use of the invention were contained in various publications, including * * * the Chicago Tribune of December 20, 1941." (Pet. C. C. p. 10.) It is thus evident that the Chicago Tribune publication was more than the mere Associated Press quotation. It also contained, at the least, photographs of the pontoon bridge. And, more significant, the publication as a whole was sufficient to enable Gearon, the inventor, so petitioners asserted, to identify the bridge as his own invention.

The petitioners' statements, elsewhere in the record, reinforce this conclusion. Letters from the inventor, in January and February 1942 asserted that the pontoon bridge used by the Army

Engineers in December 1941 was "designed, constructed and assembled in almost exact accordance with the drawings and descriptions of my invention which I had submitted" (Pet. C. C. Exh. 5, p. 17). Petitioners' attorneys repeated that claim by their letter of April 13, 1950, and revealed therein that Gearon learned of the Army Engineers' use, and that the bridge used was his invention, through the Associated Press dispatch of December 19, 1941, appearing with a picture in the Chicago Tribune the following day (Res. Mot. Exh. B, p. 49). Any publication descriptive enough for that is surely sufficient to satisfy the statutory bar.[9]

Furthermore, aside from the descriptiveness of the publications themselves, the decision below is justified by the Army Engineers' prior public use on December 18, 1941, as evidenced by the publications and petitioners' assertions. See *infra*, pp. 12-15. There is no doubt that published material, even if not of itself sufficiently descriptive to bar grant of the patent, can be relied upon to prove

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[9] The court below was of course entitled to rely upon petitioners' sworn assertions and admissions contained in the record. *White* v. *Mechanics Securities Corp.*, 269 U.S. 283, 302; *Stolte* v. *Larkin*, 110 F. 2d 226, 232 (C.A. 8); *J. R. Clark Co.* v. *Murray Metal Products Co.*, 114 F. Supp. 224, 229 (S.D. Tex.). It is not unusual for a patentee to allege facts which, while supporting his claims, act against him by revealing a prior public use or prior publication sufficient to invalidate the patent. Such was the lot of the plaintiffs in *Egbert* v. *Lippmann*, Fed. Cas. No. 4306, 8 Fed. Cas. 370 (S.D. N.Y.), affirmed, 104 U.S. 333, 335, 337; cf. *Bocz* v. *Hudson Motor Car Co.*, 19 F. Supp. 385, 387-88 (S.D. Mich.); and *A. Schrader's Sons, Inc.* v. *Wein Sales Corp.*, 9 F. 2d 306, 307 (C.A. 2).

prior public use. See, *e. g., Application of Josserand,* 188 F. 2d 486, 490-491 (C. C. P. A.)

(c). *Public Use.* The prior public use of petitioners' invention by the Army Engineers, proved by the record and petitioners' assertions, occurred on December 18, 1941, more than a year before the filing of the patent application on December 21, 1942. Prior public use sufficient to invalidate a patent need not be by the inventor or with his consent or allowance; patents have been held invalid because of prior public use by the alleged infringer, the defendant in the action. See, *e. g., Andrews* v. *Hovey,* 123 U. S. 267, opinion denying rehearing, 124 U. S. 694; *Electric Battery Co.* v. *Shimadzu,* 307 U. S. 5; *Lorenz* v. *Colgate Palmolive-Peet Co.,* 167 F. 2d 423 (C. A. 3); *Twyman* v. *Radiant Glass Co.,* 56 F. 2d 119 (C. A. 8); *Eastman* v. *Mayor, etc. of New York,* 134 Fed. 844 (C.A. 2d); *In re Bertram,* 88 F. 2d 834 (C. C. P. A.). Under the statute, a single prior public use is enough to invalidate the patent. *Smith & Griggs Mfg. Co.* v. *Sprague,* 123 U. S. 249.

Petitioners contend, however, that the Government may not assert its own prior public use because the invention was disclosed to it in confidence. However, there is nothing in the record to indicate a disclosure in confidence or pledge to secrecy. Submission of the invention to the Government does not of itself imply confidential disclosure. *Nuss* v. *United States,* 117 F. Supp. 413, 419 (Ct. Cls.); *Martin* v. *Wyeth, Inc.,* 96 F. Supp. 689, 696-97 (D. Md.), affirmed, 193 F. 2d 58 (C. A. 4). None of the papers in the record pertinent to

Gearon's submission of his invention in August 1940 substantiates petitioners' contention (Pet, C. C. Exh. 1-3, pp. 14-15; Res. Mot. Exh. B, pp. 53-56).

Furthermore, a patent is invalidated by prior public use regardless of the fact that the user learned of it in confidence. In *Lorenz* v. *Colgate-Palmolive-Peet Co.*, 167 F. 2d 423, the Court of Appeals for the Third Circuit, after exhaustively examining the pertinent authorities, concluded that the statute made no such distinction and placed no limitation on the effect of prior public use (167 F. 2d at 429):

> * * * Congress intended that if an inventor does not protect his discovery by an application for a patent within the period prescribed by the Act, and an intervening public use arises from any source whatsoever, the inventor must be barred from a patent or from the fruits of his monopoly, if a patent has been issued to him.

This was so even if the public use was "by one who employs a process in breach of a fiduciary relationship, who tortiously appropriates it or who pirates it * * *." *Id.* at p. 426. Otherwise, as the Third Circuit pointed out, the policy of the statute to establish a strict bar would be thwarted without reason and collusion would be facilitated. *Id.* at p. 430.[10]

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[10] While this Court's opinion denying rehearing in *Andrews* v. *Hovey*, 124 U.S. 694, 708, leaves open the question as to the effect of fraudulent, piratical and surreptitious use on the

In a further effort to attack the finding below as to prior public use, petitioners now urge (Pet. pp. 1-12) that the public use of the military pontoon bridge by the United States Army Engineers was merely an experimental use.[11] Once a prior public use is shown more than one year before the patent application, the proof required to support a claim that such use was experimental, must be "full, unequivocal, and convincing." *Smith & Griggs Mfg. Co.* v. *Sprague,* 123 U. S. 249, 264; *A. Schrader's Sons, Inc.* v. *Wein Sales Corp.,* 9 F. 2d 306, 308 (C. A. 2); *Eastman* v. *Mayor, etc., of New York,* 134 Fed. 844, 859 (C. A. 2). The only evidence in the record supporting petitioners' position consists of self-serving statements contained in letters by Gearon and petitioners' attorneys characterizing the use as a "test" (Pet. C. C. Exh. 5, p. 17; Res. Mot. Exh. B, p. 49). Such evidence not only falls far short of being "full, unequivocal and convincing," but is outweighed by the contrary evidence.

The Chicago Tribune news article covering the use of the bridge on December 18, 1941, includes information concerning the performance of the bridge—the feasible speed of vehicles and the number of men required for construction (Pet. C. C. p. 9). This does not suggest the tentativeness of

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rule of invalidity from prior public use, the instant case does not present a vehicle for resolving the issue since the record here falls far short of showing a tortious appropriation in breach of trust.

[11] Petitioners did not raise this question in the court below.

experiment, but rather the fruit of previously completed experiments; it is thus apparent that December 18, 1941 saw the "successful use of an art or instrument". *Midland Flour Co.* v. *Bobbitt,* 70 F. 2d 416, 419 (C. A. 8). While our armed services are continuously alert, particularly during war-time, to possible improvements in the quality of their material and equipment, the successful use of a completed invention is not rendered experimental by the fact that it may have been capable of improvement or that it may have been observed in the hope of perfecting it even further. *Smith & Griggs Mfg. Co., supra* at p. 265; *Midland Flour Milling Co.* v. *Bobbitt, supra* at pp. 419-20; *In re Bertram,* 88 F. 2d 834 (C. C. P. A.).

(d). *The Application.* While 35 U. S. C. 31, *infra,* pp. 24-25, invalidated patents in cases where there was a prior use or publication more than one year before the application for the patent was made, the provisions of the statute did not define the term "application." The Patent Office fixed the filing date of Gearon's application as December 21, 1942, the date when the application was completed by that office's receipt of the executed petition and oath (Res. Mot. Exh. A, pp. 36, 40-42). Gearon, in two supplementary oaths, accepted that date as the filing date of his application (Res. Mot. Exh. A, pp. 43, 44). Nevertheless, petitioners here contend that for the purposes of 35 U. S. C. 31 the application was filed on October 3, 1942, when Gearon submitted his draw-

ings, specifications and description and the filing fee [12] (Pet. p. 6), which was less than a year after the public use and the publication.

The construction of the statute contended for by petitioners is clearly untenable. The Patent Office regulations then in force provided that "A complete application comprises the first fee of $30, and $1 for each claim in excess of 20; a petition, specification and oath; and drawings, when required * * *" (37 C. F. R. Sec. 1.30, *infra*, p. 27) and that "An application for a patent will not be placed upon the files for examination until all its parts as required by § 1.30 shall have been received * * *." (37 C. F. R. 1.31, *infra*, p. 27). These

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[12] In addition, petitioners seek to raise the contention that the one-year period beginning December 20, 1941 did not end until December 21, 1942, because December 20, 1942, was a Sunday and 35 U.S.C. 21 *infra*, p. 24, provided that "Where the * * * last day, fixed by statute for taking any action * * * in the United States Patent Office falls on Sunday, * * * the action may be taken * * * on the next succeeding secular or business day." Apart from the fact that this contention, an obvious afterthought, was presented to the court below only in a motion for leave to file a second petition for rehearing (which was denied by the court, fn. 6, *supra*, p. 7), it is plain that it has no merit. In short, there is nothing in the statute to indicate that it was intended to be available to avoid the bar of 35 U.S.C. 31 which is measured by an extraneous event and is grounded in compelling public policy. Moreover, the Sunday problem is not here involved if the date of the Associated Press dispatch of December 19, 1941 rather than the date of the Chicago Tribune news article of December 20 is taken as the date of publication. In any case, the invalidity of petitioners' patent rests on alternate grounds—the Chicago Tribune publication on December 20, 1941, and the public use on December 18, 1941, with the latter being clearly more than one year prior to the filing date of the patent application.

provisions of the regulations which are of long standing,[13] were adopted under the power of the Commissioner of Patents "to * * * establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office" (35 U. S. C. 6, *infra*, p. 24). They are consonant with the statute, and are reasonably adapted to the carrying out of its purpose. The construction of the statute embodied therein should control. *Land* v. *Dreyer*, 155 F. 2d 383, 386 (C. C. P. A.); 2 Walker on *Patents*, Sec. 147 (Deller's Ed., 1937). Inasmuch as the filing of the oath is an essential prerequisite to the exercise of jurisdiction by the Commissioner of Patents (*Wailes Dove-Hermiston Corp.* v. *Oklahoma Contracting Co.*, 48 F. 2d 901 (N. D. Tex.) affirmed, 56 F. 2d 143 (C. A. 5); *Todd* v. *Sears, Roebuck & Co.*, 119 F. Supp. 38 (W. D. N. C.)), it is reasonable and proper to require that the oath be filed before the application is accepted as complete.[14]

The above-mentioned regulations are applicable to the invalidating provisions of 35 U. S. C. 31. An "application" for the purpose of calculating the time elapsed after a prior publication or public use "cannot justly be said to be so made * * * until

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[13] See Rules 30 and 31, Rules of Practice in the United States Patent Office, 1925 Revision. Substantially similar rules have been in effect in the Patent Office since at least 1870. E. J. Stoddard, *Annotated Rules of Practice in the United States Patent Office* (1920), p. 803, Rule 28.

[14] In adopting the 1952 Patent Code, Congress removed any doubt as to the propriety of the Commission's regulations by placing in the statute a provision that the application includes specifications, drawings and *oath*, signed and accompanied by fee. 35 U.S.C. (1952 ed.) 111, *infra*, p. 26.

[the Patent Office] is reached, and that cannot be done until the application is filed, or otherwise made there." *Campbell* v. *City of New York*, 35 Fed. 504, 506 (C. C. S. D. N. Y.). Incomplete applications, not accepted for filing, are insufficient; and the patent is invalid unless the application is completed and filed within the prescribed year. See *Henry* v. *Francestown Soap-Stone Co.*, 2 Fed. 78 (C. C. D. N. H.); *In re Incomplete Application Filed October 9, 1942*, 56 U. S. P. Q. 187.

It is thus clear that the decision of the court below granting summary judgment against petitioners on count 1 presents no question warranting review by this Court.

2. *Counts 2 and 4.* Petitioners further contend that the court below erred in granting the Government's motion to dismiss counts 2 and 4 on November 3, 1953.[15] Even if the present petition for a writ of certiorari, filed on December 31, 1954, is timely as to the court's dismissal of these counts,[16] the claims based thereon are wholly without substance.

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[15] Petitioners do not contest the dismissal of count 3 by which they sought to recover for future use of the patent. See *supra*, p. 6.

[16] Compare 28 U.S.C. 2101(c) with rules 50 and 57(a) of the Rules of the Court of Claims of the United States (1953). In its recent opinion in *United Foundation Corporation* v. *United States*, C. Cls. No. 175-52 (decided January 11, 1955), the Court of Claims held that where, as here, the various counts in a complaint are separate and distinct, its dismissal of some of such counts is such a final judgment as to those dismissed as to render such dismissals reviewable in this Court on petition for a writ of certiorari. Slip Op. p. 4 and cases there cited.

(a) Count 2 sought recovery under 28 U. S. C. 1498, *infra*, p. 23), for the alleged use by the Government of Gearon's invention during the period prior to the issuance of the patent. That statute, however, which authorizes suits only for unlawful and unlicensed use of "an invention described in and covered by a patent," was enacted to permit actions against the United States for infringement of a patent. *Crozier* v. *Krupp*, 224 U. S. 290, 303-06. Such patent rights do not arise until after a patent is issued (*Patton* v. *United States*, 110 C. Cls. 195; *Robbins* v. *United States*, 106 C. Cls. 278) and cover only periods *after* the issuance of the patent (*Rodman Chemical Co.* v. *United States*, 65 C. Cls. 39). As pointed out by the court below, "[t]o award compensation for the use of an invention when the application is still pending in the Patent Office in the formative stage would extend the period beyond seventeen years" (Pet. App. p. 20).

It is well-recognized that recovery for patent infringement can be had only with respect to periods after issuance of the patent. Several decisions distinguish between such recovery and the compensation for unauthorized tortious use previous to issuance, which is grounded upon a theory of unjust enrichment. *Ackermans* v. *General Motors Corp.*, 202 F. 2d 642, 645-46 (C. A. 4), certiorari denied, 345 U. S. 996; *Eckert* v. *Braun*, 155 F. 2d 517, 519 (C. A. 7); *DeFilippis* v. *Chrysler Corp.*, 53 F. Supp. 977, 980-81 (S. D. N. Y.), affirmed, 159 F. 2d 478 (C. A. 2), certiorari denied, 331 U. S. 848.

Under a different statute, 35 U. S. C. 42,[17] *infra*, p. 25, as petitioners point out (Pet. p. 15), recovery against the Government is permitted for its use, during the period prior to issuance of a patent, of an invention tendered it. This applies, however, only where the Commissioner of Patents, after finding that the granting of a patent "might * * * be detrimental to the public safety or defense", orders that the invention be kept secret and that the patent be temporarily withheld, and where the applicant "faithfully obeys" that order. Since no such order is involved here, this provision obviously is inapplicable. *Rodman Chemical Co.* v. *United States*, 65 C. Cls. 39, 40-42; *Fulmer* v. *United States*, 83 F. Supp. 137, 144 (N. D. Ala.).

(b) Count 4 apparently was intended originally to state in part a claim for tortious use; this would seem to explain the reference therein to the Federal Tort Claims Act (Pet. C. C. p. 6). Since actions under that Act may not be instituted in the Court of Claims, petitioners seek to find in count 4 a claim for breach of an implied contract as well as a claim for a taking of property compensable under the Fifth Amendment to the United States Constitution, both of which would be actionable in the Court of Claims under 28 U. S. C. 1491, *infra*, p. 23).

There was, of course, no express contract in the instant case. Nor are there any facts from which

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[17] This provision was supplanted by 66 Stat. 3, secs. 1-3 and the latter provisions were re-enacted as Sections 181-183 of the 1952 Patent Code.

there may be implied an agreement to pay compensation; the unaccepted offer to the Government of an invention implies no such agreement, *i. e.*, no "coming together of minds." *Russell* v. *United States*, 182 U. S. 516, 530; *Horner* v. *United States*, 114 C. Cls. 612, certiorari denied, 338 U. S. 956; *Patton* v. *United States*, 110 C. Cls. 195; *Rodman Chemical Co.* v. *United States*, 65 C. Cls. 39. Likewise, there has been no taking which is compensable under the Fifth Amendment. None of the elements of such a taking are here present, since Gearon at all times retained ownership and control of his invention. Cf. *United States* v. *General Motors Corp.*, 323 U. S. 373, 378; *United States* v. *Causby*, 328 U. S. 256, 261-3, 264; *United States* v. *Kansas City Ins. Co.*, 339 U. S. 799, 804-808. The most that the Government did was to use Gearon's invention without authorization (cf. *Schillinger* v. *United States*, 155 U. S. 163; *De Forest Co.* v. *United States*, 273 U. S. 236, 240), but since the statutory requirements for establishing the right to receive compensation for such use have not been satisfied (see *supra*, pp. 15-18), petitioners cannot recover therefor.

In any event, petitioners' claims under 28 U. S. C. 1491 are barred by the applicable six year statute of limitations, 28 U. S. C. 2501, *infra*, pp. 23-24. The alleged breach of contract or compensable taking occurred on December 18, 1941 when the Government allegedly used petitioners' invention. The petition in the Court of Claims, seeking recovery therefor, was not filed until April 20, 1953, much more

than six years thereafter. The decision of the court below dismissing counts 2, 3, and 4 is therefore clearly correct.

CONCLUSION

For the reasons stated, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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JANUARY, 1955.

APPENDIX

The pertinent provisions of Title 28, United States Code (1952 Edition) are as follows:

Sec. 1491. The Court of Claims shall have jurisdiction to render judgment upon any claim against the United States:

(1) Founded upon the Constitution; or

(2) Founded upon any Act of Congress; or

(3) Founded upon any regulation of an executive department; or

(4) Founded upon any express or implied contract with the United States; or

(5) For liquidated or unliquidated damages in cases not sounding in tort.

* * * * *

Sec. 1498. Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by action against the United States in the Court of Claims for the recovery of his reasonable and entire compensation for such use and manufacture. * * *

* * * * *

Sec. 2501. Every claim of which the Court of Claims has jurisdiction shall be barred unless the petition thereon is filed, or the claim is

referred by the Senate or House of Representatives, or by the head of an executive department within six years after such claim first accrues. * * *

The pertinent provisions of Title 35, United States Code (1946 Edition) are as follows:

Sec. 6. The Commissioner of Patents * * * may, subject to the approval of the Secretary of Commerce, from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

* * * * *

Sec. 21. Where the day, or the last day, fixed by statute for taking any action or paying any fee in the United States Patent Office falls on Sunday, or on a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

* * * * *

Sec. 31. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, * * * not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more

than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

* * * * *

Sec. 42. Whenever the publication or disclosure of an invention by the granting of a patent might, in the opinion of the Commissioner of Patents, be detrimental to the public safety or defense he may order that the invention be kept secret and withhold the grant of a patent for such period or periods as in his opinion the national interest requires: * * *

When an applicant whose patent is withheld as herein provided and who faithfully obeys the order of the Commissioner of Patents above referred to shall tender his invention to the Government of the United States for its use, he shall, if and when he ultimately receives a patent, have the right to sue for compensation in the Court of Claims, such right to compensation to begin from the date of the use of the invention by the Government: * * *

* * * * *

Sec. 69. In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff

or his attorney thirty days before, may prove on trial any one or more of the following special matters: * * *

* * * * *

Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than one year prior to his application for a patent therefor: or, * * *

* * * * *

Fifth. That it had been in public use or on sale in this country for more than one year before his application for a patent, or had been abandoned to the public.

* * * * *

The pertinent provisions of Title 35, United States Code (1952 Edition) are as follows:

Sec. 111. Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

The pertinent provisions of Title 37, Code of Federal Regulations (1939 Edition) are as follows:

Sec. 1.30. Applications for letters patent of the United States must be made to the Commissioner of Patents, and must be signed by the inventor, or by one of the persons indicated in § 1.25. (* * *) A complete application comprises the first fee of $30, and $1 for each claim in excess of 20; a petition, specification, and oath; and drawings, when required. * * *.

Sec. 1.31. An application for a patent will not be placed upon the files for examination until all its parts as required by § 1.30 shall have been received.

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